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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,941	02/22/2002	Ferdinand Hendriks	YOR920010731US1(15160)	4472

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Garden City, NY 11530

EXAMINER

DOAN, DUYEN MY

ART UNIT	PAPER NUMBER
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2152

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/081,941	HENDRIKS ET AL.	
	Examiner	Art Unit	
	Duyen M. Doan	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/23/06 has been entered. Claims 1-55 are amended for examination.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13, 18, 19-30, 35-47, 52-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiigi (us pat 6,564,249) in view of Sun et al (us 2002/0143994).

As regarding claim 1, Shiigi discloses establishing by at least some of the network of computers a connection to said instant messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67; col.4, lines 1-49, plurality of client computers adapted for handwriting input are used by users); providing to a plurality of

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users by said instant messaging system a graphical user interface comprising a recording field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67, each user enter handwritten message through a graphical interface); displaying in said recording field for viewing by said users a chat record comprising one or more instant messages from a currently ongoing instant messaging session (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67, each user enter handwritten message through a graphical interface, also see figure 2b); directly inputting handwritten stroke information message objects anywhere within said recording field to thereby annotate said one more instant text messages in said chat record (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67, each user enter handwritten message through a graphical interface); distributing by said instant messaging system said annotated one or more instant text messages for viewing by said plurality of users in said recording field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67; col.4, lines 1-49, plurality of client computers adapted for handwriting input are used by users).

Shiigi discloses the handwritten messages are enter by client through a graphical interface to send email messages to other clients. Shiigi does not explicitly disclose chat messages.

Sun teaches communicating the handwritten messages in a chat system (see Sun pg.1, par 7).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Sun to the method of Shiigi to communicate handwritten message in a chat system because by using the chat system

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to send handwritten messages would allow clients in the network instantly send and receive messages.

A person with ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teaching of Sun to the method of Shiigi to communicate handwritten messages in the chat system because using ink messages in the chat system would provide benefit and convenient to client where conventional text is less efficient (see Sun pg.1, par 6-7).

As regarding claim 2, Shiigi-Sun discloses wherein said message objects are IM objects (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 3, copying a plurality of messages from other application (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 4, messaging system is of a peer-to-peer type (see Sun pg.1, par 3). Peer-to-peer chat system is conventional technique to connect clients in the chat system.

As regarding claim 5, Shiigi-Sun discloses forwarding said handwritten stroke information to at least one participant (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 6, Shiigi-Sun discloses wherein said messaging system updates chat record of all said current messages for distribution to, and handwritten stroke information annotation by users of said messaging system, said method further comprising appending said handwritten stroke information onto said chat record (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

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As regarding claim 7, Shiigi-Sun discloses wherein said establishing said connection is initiated by a first of a plurality of said users of said messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 8, Shiigi-Sun discloses said graphical user interface comprises a handwritten stroke input field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 9, Shiigi-Sun discloses wherein said graphical user interface comprises an awareness field (see Sun pg.3, par 25-27). The same motivation was utilized in claim 1 applied equally well to claim 9.

As regarding claim 10, Shiigi-Sun discloses wherein said graphical user interface comprises a text input field (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 11, entering text into said text input field wherein said text is associated with said message objects for transmission to said messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 12, Shiigi-Sun disclosed entering handwritten stroke information into said handwritten stroke input field wherein said handwritten stroke information is associated with said message objects for transmission to said messaging system (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

As regarding claim 13, Sun-Becker disclosed logging and displaying a complete history of said current messages in said recording field of said graphical user interface (see Shiigi abstract, col.2, lines 1-36, col.3, lines 40-67).

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As regarding claim 18, Shiigi-Sun discloses searching said recording field based on user-selected criteria (see Shiigi col.2, lines 21-67).

As regarding claims 19-30 the limitations are similar to claims 1-13, therefore rejected for the same rationale as claims 1-13.

As regarding claim 35 the limitations are similar to claim 18, therefore rejected for the same rationale as claims 18.

As regarding claims 36-47 the limitations are similar to claims 1-13, therefore rejected for the same rationale as claims 1-13.

As regarding claim 52 the limitations are similar to claim 18, therefore rejected for the same rationale as claims 18.

As regarding claim 53-55, the limitations are similar to claim 1-13, , therefore rejected for the same rationale as claim 1-13.

Claims 14-17, 31-34, 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiigi and Sun as applied to claim 1 above, and further in view of Lloyd et al us pat 6779178 (hereinafter Lloyd).

As regarding claim 14, Shiigi and Sun disclosed all the limitation of claim 1 above, but fail to disclose URL for providing location information of an associated said message objects in said record.

Lloyd teaches URL for providing location information of an associated said message objects in said recording field (col.22, lines 34-46).

It is obvious to one with ordinary skill in the art at the time of the invention was made to combine the teaching of Lloyd with the method of Sun-Becker to have messages contain URL for providing information location for the purpose of when the text is displayed with a URL in the status bar, user viewing the message could go to the URL by clicking on the link (see Lloyd col.22, lines 43-46).

As regarding claim 15, Shiigi-Sun-Lloyd disclosed each of said plurality of users may navigate through said recording field to said associated said message objects by selecting said at least one URL whereby said associated said message objects are displayed to said plurality of users (see Lloyd col.22, lines 43-46). The same motivation was utilized in claim 14 applied equally well to claim 15.

As regarding claim 16, Shiigi-Sun-Lloyd disclosed annotating in said instant text messages in said recording field by any of said plurality of users; and using said hyperlink for alerting said plurality of users of said annotation (see Lloyd col.22, lines 43-46, HTML tag to create a link). The same motivation was utilized in claim 14, applied equally well to claim 16.

As regarding claim 17, Shiigi-Sun-Lloyd disclosed a) navigating to a desired said message object in said recording field (see Sun pg.3, paragraph 25-27); b) selecting the desired said message to be annotated (see Sun pg.3, paragraph 25-27); and c) adding new handwritten stroke information message objects to said recording field (see Sun pg.3, paragraph 25-27).

As regarding claims 31-34 the limitations are similar to claims 14-17, therefore rejected for the same rationale as claims 14-17.

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As regarding claims 48-51 the limitations are similar to claims 14-17, therefore rejected for the same rationale as claims 14-17.

Response to Arguments

Applicant's arguments with respect to claims 1-55 have been considered but are moot in view of the new ground(s) of rejection.

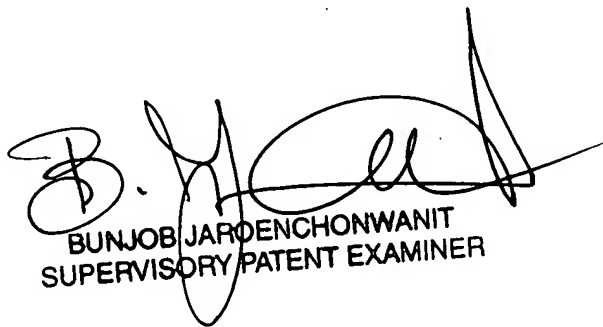
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob A. Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner
Duyen Doan
Art unit 2152


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER